

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellants:	Castelli et al.	Examiner: J. Hirl
Serial No:	09/916,935	Group Art Unit: 2129
Filed:	July 27, 2001	Docket: YOR920010461 (8728-524)
For:	METHOD AND APPARATUS FOR PREDICTION OF COMPUTER SYSTEM PERFORMANCE BASED ON TYPES AND NUMBERS ACTIVE DEVICES	

REPLY BRIEF

This is a Reply to the Examiner's Answer mailed on April 30, 2007.

Appeal from Group 2129

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This brief is respectfully submitted to address certain issues and contentions raised in the Examiner's Answer to the Appellants' Appeal Brief of October 24, 2006. Appellants respectfully submit that the Examiner's Answer and Final Office Action collectively fail to (i) present a *prima facie* case of anticipation based on Sweet [U.S. Pat. No. 6,836,800], (ii) or establish that claim 42 contains new matter which is not properly supported by the specification under 35 U.S.C. §112.

New Matter

The Examiner's Answer does not contain any sound legal or factual reasoning that fairly demonstrates how claim 42 contains new matter. Appellants' Appeal Brief clearly demonstrates how the subject matter of claim 42 does not contain "new matter" and how the subject matter is supported in the specification in compliance with the written description requirement of 35 U.S.C. 112. Indeed, Appellants cite specific parts of the specification that support each limitation of claim 42. (See, e.g., page 8 of the Appeal Brief).

Instead of directly addressing Appellants issues and arguments raised in the Appeal Brief or otherwise attempting to factually refute the supporting citations, the Examiner provides a lengthy, verbose response (in pages 12-16 of the Answer) which is rather confusing and seemingly off point. The Examiner's Answer does not specifically focus on the claim language of claim 42 when attempting to explain how the subject matter of claim 42 is not supported by the specification.

For example, in the Appeal Brief, Appellants cite various disclosure in the specification (e.g., FIGs. 2-8, page 13, line 6-page 22, line 4, FIG. 13, page 26, lines 7-22, FIG. 15, element 1501, and page 29, lines 7-13) that provides clear support for the

claim limitations of *predicting the subsequent resource utilization, based upon the first monitored values, the second monitored values, and the third monitored values*, as recited in claim 42. However, the Examiner's Answer does not fully address, and simply ignores, many of these cited provisions of the specification. The Examiner's Answer attempts to explain, with a seemingly confusing and irrelevant analysis, how the subject matter in FIG. 15, p. 29, lines 3-21 of the specification does not support the subject matter of claim 42.

For example, on page 14 of the Examiner's Answer, the Examiner states that FIG. 15 of the specification as described on page 29, lines 3-21 cites simultaneous resource use which is incongruent to a limitation requiring variation over a period of time. While claim 42 recites that the number of devices can vary, the Examiner provides no reasonable explanation as to why simultaneous resource use would be incongruent to a varying number of devices, or otherwise reasonable explain the relevance of this finding to justify the conclusion of new matter. Overall, Appellants submit that the erroneousousness of the new matter and 112 rejections is underscored by the Examiner's failure in both the Final Office Action and the Answer to provide a clear and reasonable explanation to support a finding of new matter or non compliance with 112 written description.

Anticipation

On page 19 of the Examiner's answer, the Examiner essentially states that the trending predictions discussed in Sweet (in col. 4, line 46) are equivalent to predicted subsequent resource utilization based on monitored values of the contemporaneous resource utilization and a number of active devices, as essentially claimed in claim 1.

Appellants respectfully disagree. There is no teaching in Sweet that indicates that trending data is based on the contemporaneous resource utilization and the number of active devices.

On page 19 of the Examiner's answer, the Examiner essentially states that reaching of a threshold in Sweet (in col. 2, lines 55-56) means identifying resource saturation, as essentially claimed in claim 21. Appellants respectfully disagree with the Examiner's overly broad interpretation of a threshold. Exceeding a threshold need not mean that a resource has become saturated. For example, assume the resource is a network, and the threshold is a rate of data transmission. Exceeding the threshold of data transmission, could merely indicate a higher data load (e.g., 200 bits per second) than normal (e.g., 100 bits per second), and not resource saturation.

On page 20 of the Examiner's answer, the Examiner essentially states planning an upgrade based on an exceeded threshold in Sweet (in col. 3, lines 24-40) includes predicting the effects of adding the new device, as essentially claimed in claim 31. Appellants respectfully disagree. Exceeding a threshold may indicate a particular resource should be upgraded, but it cannot indicate what the effects of that particular upgrade will be.

On page 23 of the Examiner's Answer, the Examiner essentially states that predicting the effects of adding a new device is part of the capacity upgrade discussed in Sweet (in col. 4, line 46, col. 2, line 30) since the new device will provide greater capacity. Appellants respectfully disagree. There is no teaching in Sweet that a capacity upgrade predicts the effects of performing that capacity upgrade. In fact, adding a new device could actually lower capacity if that new device conflicts with existing devices.

Conclusion

Accordingly, it is respectfully requested that the Board reject the Examiner's assertions of "new matter" and reverse the claims rejections under 35 U.S.C. § 102(e) and 112.

Respectfully submitted,

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